

REMARKS

The Examiner is respectfully requested to reconsider his rejection of claims 1 - 4 and 10 under 35 U.S.C. §102(b) as being anticipated by United States Patent 6,084,968 to Kennedy, et al.

The Examiner is respectfully requested to review his interpretation of the Kennedy et al. reference and the manner in which he has applied same to the claims in the instant application. The Examiner asserts that each and every element claimed by Applicants is found in the Kennedy, et al. reference. The Examiner in his rejections in the above-noted Office Action cites the specific language found in Applicants' claims and bases his anticipation rejections on excerpts which in fact do not support his assertions.

The Examiner's rejections are quoted *verbatim* and listed *seriatim*, with Applicants' responses to the specific rejection presented immediately thereafter.

The Examiner says: "As to claim 1, Kennedy et al. discloses a method for setting basic means of access for operation of devices of which the operation is controllable by electronic means, comprising: the devices comprising mobile phones, small computer-controlled consumer devices with relatively low level of computing power, computers, motor vehicles, control terminals for industrial processes, all of which devices may require authentication prior to operation [Column 3, lines 8-46]..."

Response: Applicants respectfully submit that Kennedy et al. do not disclose the variety of devices that are claimed by Applicants. In Column 3, lines 8 - 46 which is the supporting basis of the rejection, Kennedy is only referring to cellular phones or personal communication devices. There is no mention of the other devices. In order to distinguish the invention, Applicants have included "New" Claim 11 which excludes the mobile phone. Applicants believe that their invention, including the "mobile phone" is not obvious in view of the additional limitations placed in the claims which render the claims not obvious to the skilled artisan.

The present invention can be used by a particular software application on the system to verify access authorization. This could be a single software application, which evaluates the security token and is running on top of the used hardware.

Applicants detail the usage of the token to provide specific configuration information, which defines constraints for the usage of a particular user. This "constraint" e.g. temporary deactivation, limits the usage of a reduced feature set. This is more than just "authentication". It adds "authorization" patterns. The support for this is disclosure is found at page 15, the last full paragraph:

"A company telephone system consists of 20 telephones hierarchically grouped into three levels, with corresponding scopes of functions. The telephone sets themselves are produced uniformly and are assigned their actual features only by means of the configuration procedure, which enables or disables various logic components in the sets depending on the customer's specific requirements."

To reiterate, Applicants are entitled to retain mobile phone as one of the functioning devices in their invention in view of the limitations now found in Claim 1. An important feature of the present invention, is access to different (software) functions, based on the privileges of the user who identified himself/herself to the system.

"establishment of a link between a personal authentication system supplied with encryption data and a logic system able to control an electronic device control [Column 3, lines 8-46]"

Response: Kennedy, et al. are setting up a connection between the smart card and the cellular phone, but they are using a completely different security system to do so. It is essential to note in properly evaluating the overall system disclosed by Kennedy, et al. that a part of an algorithm has to be stored on the smart card (Column 3, line 10 - 21), the other part on the device in question. Applicants have added language to the excerpt of the claim quoted above and have added language that states: "said encryption data being stored solely in said authentication system." In the event a public or private key infrastructure is used, the required keys are stored in their entirety, for example, on the smart card as well as on the device. In Applicants' invention,

a key may be present on the device and the same key on the smart card, so a challenge/response can be used to authenticate the smart card. However Applicants are not splitting the key (as Kennedy, et al.) such that the first 64 bits of the key are on the card and the remaining 64 bits (in the case of a 128 bit key) are on the device.

"assignment of predetermined means of access to the electronic device control associated with the authentication system the predetermined means providing access to the physical hardware resources and access to different software functions, based on the privileges of the user who identified himself to the system, the software function evaluates a security token and is running on top of the physical hardware [Column 5, lines 16 -65]"

Response: In the Kennedy, et al. patent, when considering "access," there is only one level of access. An important distinguishing key to the present invention is that there are different levels of access to differentiate the different levels of authorization that persons with different roles may need. The Examiner is referred to page 6 of their specification. The different levels are mentioned on page 6. At that location, there is a disclosure of the system being open to progressive hierarchies of access rights to the device, for example, by the production of a Master SmartCard which can be issued to customers' service personnel in order to configure large numbers of individual devices. Further, on page 6: "Applying the method in accordance with the invention, and based on the stipulation that a single SmartCard is to be able to configure any number of devices but that only a Master SmartCard or a personal SmartCard can be used to shut down and/or startup/restart the devices, a device manufacturer may do the following..."

Applicants differentiate between a single (standard) smart card and a Master Smart Card. The different levels are mentioned in the portion of Claim 1 that reads: "...assignment of predetermined means of access to the device associated with the authentication system." In order to clarify the invention over the prior art, Applicants have added language which states: "said predetermined means of access being dependent upon the level of authorization that is set in said personal authorization system."

"enabling of the means for access predetermined for the authentication system dependent on the result of the check. [Column 5, lines 16-64]"

Response: Applicants cannot locate any teaching or disclosure related to a multi-level security system in Column 5, lines 16 - 64 quoted by the Examiner. Kennedy, et al. only refers to one level of security. There is no differentiation based on the role of the user.

The Examiner continues: "As to claim 2, Kennedy et al. disclose that the basic means of access of functions of the device comprise at least one of the following means: disable operation of the devices, enable operation of the devices, or enable configuration of device. [Column 6, lines 6-11]"

Response: There is no mention of enabling the configuration of the device in Kennedy, et al. Column 6, lines 6-11 so there is no anticipation of the elements defined in Claim 2.

The Examiner continues: "as to claim 3, Kennedy et al. disclose that the link is made without need for intermediate software layers. [Column 6, lines 39-47]"

Response: There is no mention that the link is made without the need for an intermediate software layer in Kennedy, et al. at Column 6, lines 39 - 47, so there is no anticipation of the elements defined in Claim 3.

The Examiner continues: "As to claim 4, Kennedy et al. disclose in addition, the step of reading at least one of the following features embodied within the authentication system: firmware programs, device-specific command sequences for execution of specific device-specific functions, cryptographic keys, cryptographic algorithms, and individual decision-making logic. [Column 6, lines 39-47]"

Response: There is no mention of the step of reading at least one of the features embodied within the authentication system in Kennedy, et al. at Column 6, lines 39 - 47, so there is no anticipation of the elements defined in Claim 4.

The Examiner continues: "As to claim 10, Kennedy et al. disclose program code areas for the execution or preparation for execution of the steps when the program is installed in a computer. [Column 4, lines 39-56]"
Response: Column 4, lines 39-56 are referring to an encryption algorithm and how the keys should be stored. Applicants request clarification as to the cited lines in Kennedy, et al. should relate to Applicants' Claim 10.

The Examiner is respectfully requested to reconsider his rejection of claims 5 - 9 under 35 U.S.C. §103(a) as being unpatentable over United States Patent 6,084,968 to Kennedy, et al. as applied to Claim 1, and further in view of United States Patent 6,415,144 to Findikli, et al.

The Examiner acknowledges that Kennedy, et al. does not teach the method including configuration of the devices by authorized persons. With regard to claim 5, Findikli, et al. teach download of configuration information, in an unsecure way. There is no connection to any security system on the device. There is also no way to personalize/customize the configuration without the mobile phone being registered with a service provider, which may not always be the case for all the devices (like to a landline phone, or a washing machine). There is no basis to combine these references.

As to the rejection of Claim 7, Kennedy doesn't teach the access of different groups or people with different roles.

As to Claims 8 and 9, there is no basis for combining the references. It was demonstrated above that Kennedy and Findikli do not describe the inventions that warrant the proposed combination. These references, alone or in combination do not disclose the invention defined in claims 8 and 9.

Claim 11 is new and omits the mobile phone which is claimed in Claim 1.

Kennedy, et al. and Findikli, et al., alone, or in combination, do not disclose or even imply the elements of Claims 5 - 9 of the present invention. In the rejection, the Examiner is selectively picking and choosing individual elements disclosed in the references to the exclusion of what the references as a whole teach to one skilled in the art.

In order to analyze the propriety of the Examiner's rejections in this case, a review of the pertinent applicable law relating to 35 U.S.C. § 103 is warranted. The Examiner has applied the Kennedy, et al. and Findikli, et al. references discussed above using selective combinations to render obvious the invention.

The Court of Appeals for the Federal Circuit has set guidelines governing such application of references. These guidelines are, as stated are found in Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1143, 227 USPQ, 543, 551:

When prior art references require selective combination by the court to render obvious a subsequent invention, there must be some reason for the combination other than hindsight gleaned from the invention itself.

A representative case relying upon this rule of law is Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 5 USPQ 2d 1434 (Fed. Cir. 1988). The district court in Uniroyal found that a combination of various features from a plurality of prior art references suggested the claimed invention of the patent in suit. The Federal Circuit in its decision found that the district court did not show, however, that there was any teaching or suggestion in any of the references, or in the prior art as a whole, that would lead one with ordinary skill in the art to make the combination. The Federal Circuit opined:

Something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination. [837 F.2d at 1051, 5 USPQ 2d at 1438, citing Lindemann, 730 F.2d 1452, 221 USPQ 481, 488 (Fed. Cir. 1984).]

The Examiner in his application of the cited references is improperly picking and choosing. The rejection is a piecemeal construction of the invention. Such piecemeal reconstruction of the prior art patents in light of the instant disclosure is contrary to the requirements of 35 U.S.C. § 103.

The ever present question in cases within the ambit of 35 U.S.C. § 103 is whether the subject matter as a whole would have been obvious to one of ordinary skill in the art following the teachings of the prior art at the time the invention was made. It is impermissible within the framework of Section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art. (Emphasis in original) In re Wesslau 147 U.S.P.Q. 391, 393 (CCPA 1965)

This holding succinctly summarizes the Examiner's application of references in this case, because the Examiner did in fact pick and choose so much of the Findikli, et al. reference with respect to "device specific configuration data" to support the rejection and did not cover completely or accurately in the Office Action the full scope of what these varied disclosure references fairly suggest to one skilled in the art.

Further, the Federal Circuit has stated that the Patent Office bears the burden of establishing obviousness. It held this burden can only be satisfied by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the reference.

Obviousness is tested by "what the combined teachings of the references would have suggested to those of ordinary skill in the art." In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). But it "cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." ACS Hosp. Sys., 732 F.2d at 1577, 221 USPQ at 933. [837 F.2d at 1075, 5 USPQ 2d at 1599.]

The Court concluded its discussion of this issue by stating that teachings or references can be combined only if there is some suggestion or incentive to do so.

In the present case, the skilled artisan, viewing the references would not be directed toward Applicants' system. There can reasonably be no system such as Applicants emanating from the Kennedy, et al. and Findikli, et al. references as the basic focus of the two references are different. There is no proper basis to combine them.

Applicants have attempted in this response to include language limitations to specifically define the invention and to clear up any ambiguities that may have existed in the wording heretofore. Applicants believe that the amended claims are in a form which should result in their allowability. If there are additions which could result in the claims being allowed, Applicants' attorney would be pleased to speak with the Examiner by phone concerning such action at a mutually agreeable time and will cooperate in any way possible.

Respectfully Submitted,



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I hereby certify that this amendment response is being telefaxed to (703) 872-9306 on the date indicated below addressed to Commissioner of Patents & Trademarks, Post Office Box 1450, Alexandria, VA 22313-1450

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